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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* RYAN J. SNODGRASS
9 and
10 MICHAEL MCDANIEL
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13 Appeal 2009-001297
14 Application 09/876,611
15 Technology Center 3600
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18 Decided: August 26, 2009
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22 *Before:* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
23 JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

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25 CRAWFORD, *Administrative Patent Judge.*
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28 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 38 to 65. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented a method for identifying and providing targeted content to users having common interests (Spec. 1).

Claim 38 under appeal reads as follows:

38. A computer-implemented method,
comprising:
tracking referrals of users from each of a
plurality of referring web sites to a target web site
that hosts an electronic catalog of items, said
referrals resulting from user selections of links
provided on the referring web sites;
identifying a group of users referred to the
target web site by a selected subset of said
plurality of referring web sites, said group of users
comprising a plurality of users, and representing a
subpopulation of a general user population of the
target web site;
collecting user activity data reflective of
preferences of particular users for particular items
represented in the electronic catalog of items, said
user activity data encompassing actions of both
members and non-members of said group of users;
identifying a set of items that correspond to
group preferences of said group of users, wherein
the set of items is identified based on the collected
user activity data of both the members and the
non-members of said group of users; and
causing the set of items to be displayed (a)
on the target web site to users who are referred
thereto from a referring web site in said subset of
referring web sites, and/or (b) on a referring web
site in said subset of referring web sites.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| | | |
|----------|-----------------|---------------|
| Aggarwal | US 6,307,965 B1 | Oct. 23, 2001 |
| Aggarwal | US 6,356,879 B2 | Mar. 12, 2002 |

Osmar R. Zaiane et al., *Discovering Web Access Patterns and Trends by Applying OLAP and Data Mining Technology on Web Logs*, Proceedings of the Advances in Digital Libraries Conference, 19-29 (1998) (hereinafter referred to as "Zaiane").

The Examiner rejected claims 46 and 59 under 35 U.S.C. § 112, second paragraph as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

The Examiner rejected claims 38 to 65 under 35 U.S.C. § 103(a) as being unpatentable over Aggarwal '879 in view of Zaiane.

ISSUES

Have Appellants shown that the Examiner erred in holding that claims 46 and 59 do not comply with 35 U.S.C. § 112, second paragraph because there is an omission in an essential step?

Have the Appellants shown that the Examiner erred in rejecting claims 38 to 65 under 35 U.S.C. § 103(a) as being unpatentable over Aggarwal '879 in view of Zaiane because the combined teachings of the prior art do not teach the step of identifying a group of users referred to the target web site by a selected subset of a plurality of referring web sites and because there would be no reason to combine the teachings of Aggarwal '879 and Zaiane in the manner suggested by the Examiner.

FINDINGS OF FACT

Aggarwal '879 discloses a method for making product recommendations based on customer user behavior (col. 1, ll. 6 to 9). The user behavior includes user browsing and purchasing behavior (col. 2, ll. 10 to 12). The recommendations are made at an e-commerce site (col. 2, ll. 12 to 13). The method is implemented by deriving product characterizations for each product and creating customer characterizations for each customer based on the products browsed or bought (col. 2, ll. 22 to 36). The customer characterizations are used to cluster users into peer groups and the product recommendations are made using the customer characterizations and categorized peer groups (col. 2, ll. 31 to 33). The product characterizations are derived from text characterizations of each the products (col. 2, ll. 40 to 48). This process to create product characterizations includes selecting those words contained within the text descriptions of each product offered at the e-commerce site which prove to be valuable indicators of customer behavior (col. 4, ll. 60 to 64). Some words that are valuable indicators of customer behavior at a site regarding movies or CDs, for example, include words such as "action," "romance," "mystery," "drama," etc. (col. 4, ll. 64 to 67). The product characterizations are used to group customers into clusters or peer groups (col. 5, ll. 6 to 7).

Zaiane discloses that the behavior of a web page reader is imprinted in the web server log files and that the analysis of the behavior or users can be used to identify populations of potential customers for electronic commerce (page 1). The web servers register a web entry for every single access they get in which they save the URL requested (page 1). Zaiane also discloses

that recent research and development of data mining technology have promoted some studies on efficient data mining for user access patterns that can be used to make wise marketing decisions (page 2).

PRINCIPLES OF LAW

Second paragraph of 35 U.S.C. § 112

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

The Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the Examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

A claim which fails to interrelate essential elements of the invention as defined by Applicants in the specification does not comply with the requirements of 35 U.S.C. § 112, second paragraph. *See In re Venezia*, 530 F.2d 956, 958-59 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 1005 (CCPA 1968).

Obviousness

An invention is not patentable under 35 U.S.C. § 103 if it is obvious. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007). The facts underlying an obviousness inquiry include: Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In addressing the findings of fact, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR* at 416. As explained in *KSR*:

If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida*

1 and *Anderson's-Black Rock* are illustrative - a court
2 must ask whether the improvement is more than
3 the predictable use of prior art elements according
4 to their established functions.

5 *KSR* at 417.

6 A prior art reference is analyzed from the vantage point of all that it
7 teaches one of ordinary skill in the art. *In re Lemelson*, 397 F.2d 1006, 1009
8 (CCPA 1968) (“The use of patents as references is not limited to what the
9 patentees describe as their own inventions or to the problems with which
10 they are concerned. They are part of the literature of the art, relevant for all
11 they contain.”). Furthermore, “[a] person of ordinary skill is also a person of
12 ordinary creativity, not an automaton.” *KSR* at 421. The obviousness
13 analysis need not seek out precise teachings directed to the specific subject
14 matter of the challenged claim, for a court can take account of the inferences
15 and creative steps that a person of ordinary skill in the art would employ. *Id.*
16 at 418.

17 On appeal, Applicants bear the burden of showing that the Examiner
18 has not established a legally sufficient basis for combining the teachings of
19 the prior art. Applicants may sustain their burden by showing that where the
20 Examiner relies on a combination of disclosures, the Examiner failed to
21 provide sufficient evidence to show that one having ordinary skill in the art
22 would have done what Applicants did. *United States v. Adams*, 383 U.S. 39,
23 52 (1966).

ANALYSIS

We will not sustain the Examiner's rejection under 35 U.S.C. § 112, second paragraph. The Examiner is of the view that essential steps are missing from claims 46 and 59. In this regard, the Examiner reasons that in accordance with the recitations in claim 38, the user is on the target web site and that therefore a step must be incorporated into the methods of claims 46 and 59 to get the user back to the referring website so that the items can be displayed thereon. However, the claims do not recite that the same user returns to the referral website so that the items can be displayed. The claims merely recite that the items are caused to be displayed on the referral website. This display is not connected to a user but rather to the referral website. As such, the claims recite that the items are displayed on the referral website so that anyone who accesses the website even users who have never visited the target website can view the items.

We will not sustain the Examiner's rejection under 35 U.S.C. § 103. Aggarwal '879 forms the peer groups based on the products browsed or bought by customers and makes product recommendations based on a text characterization of the product names. Zaiane discloses that information on websites visited by users can be used for marketing purposes. The Examiner reasons that it would have been obvious to include the information about the websites visited in the data used to form peer groups. However, the Examiner has not established how this website information would be used to provide product recommendations. Aggarwal '879 uses a text characterization process to derive the product characterization in which certain words in the product name are considered valuable indicators of the customer behavior. The Examiner has not established how the text

1 characterization process disclosed by Aggarwal '879 can be used in regard
2 to the name of websites. We note in this regard that many website names do
3 not include the names of products sold at the website.

4 In addition, the Examiner has not articulated a reason for combining
5 the teachings of Aggarwal '879 and Zaiane i.e., using the websites visited
6 information in the system of Aggarwal '879 to make product
7 recommendations. As websites do not always relate strictly to one product,
8 information that a consumer visited a certain website would not necessarily
9 produce any valuable information regarding the products that the consumer
10 is interested in and as such would not contribute to making product
11 recommendations. In contrast, the information about the products bought or
12 browsed gives direct information about the products a consumer is interested
13 in. As such, in our view, there would be no reason to include the website
14 information as taught by Zaiane in the process of Aggarwal '879.

15 In view of the foregoing, we will not sustain the Examiner's rejection
16 under 35 U.S.C. § 103.

17 CONCLUSION OF LAW

18 On the record before us, Appellants have shown that the Examiner
19 erred in rejecting the claims.
20

DECISION

The decision of the Examiner is reversed.

REVERSED

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